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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,748	12/02/2000	Heather Philpott	PH-17	2377
26841	7590	09/19/2005	EXAMINER	
MARK P. BOURGEOIS P.O. BOX 95 OSCEOLA, IN 46561			PARA, ANNETTE H	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/728,748

Applicant(s)

PHILPOTT, HEATHER

Examiner

Annette H. Para

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

Art Unit: 1661

### DETAILED ACTION

The answer to the 1.105 Requirement has been received and entered.

#### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right publication number 971485 published on February 16, 1998 in the European Community, in view of applicant's admission that 'Glory' was sold in Europe in May 1998 (page 2 of reply filed July 19, 2005).

Claim 1 is drawn to a Veronica plant named 'Glory'

The cited publication teaches the Veronica plant 'Glory'.

In response to the 1.105 Requirement for Information, Applicant admits that first sales of the instant plant took place in the United Kingdom in May 1998. *In re Elsner* the Court of Appeals Federal Circuit states that foreign sales can enable a publication if one skilled in the art would have been able to reproduce the claimed plant without undue experimentation. The reproduction of Veronica spp. is clearly explained in the Dictionary of Gardening on page 652 top of second column. On the answer to the 1.105 requirement, applicant states that they had some propagation problems. It is unclear as to whether it is due to using the wrong rooting compound or to not take the cutting at the most opportune time of the year. The Dictionary of Gardening clearly states the cutting should be harvested in late summer and root in a well-drained propagating mix. One skilled in the art would be able to reproduce and propagate the claimed plant without undue experimentation. The Court also states that the sales must not be an isolated solitary occurrence and that they were such of a nature that the public would have known of the invention. For example, the UPOVROM list the applicant Nordic nurseries. This would

Art Unit: 1661

indicate that one of ordinary skill in the art would have known where to obtain the claimed plant. By searching the Internet, one of ordinary skill in the art, for example, could easily search Nordic Nurseries for their address: 29386 Haverman Road Abbotsford, BC V4X2P3 Canada, phone number: 604-607-7074, and fax number 604-607-7073 as noted in the following internet site ([http://www.nordicplants.com/main.htm?page\\_id=30000](http://www.nordicplants.com/main.htm?page_id=30000)). One of ordinary skill in the art would have been able to check the availability of the claimed plant and where to purchase that plant as well as under what name it was sold. However, the breeder is in the business of selling plants and the instant plants could have been obtained at the previously cited address.

This, in combination with the above-described UPOV application elicits a 102(b). See below for more information.

The claimed Veronica variety 'Glory' is described in the Plant Breeder's Right cited above and published more than one year prior to filing in the U.S.

The published grant, application and published proposed denomination are each "printed publications" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221,226,210 USPQ 790,794 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number and grant number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the grant are obtainable through the European Community Register of Varieties. Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929,133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether 'Siokra' seeds were available to a skilled

Art Unit: 1661

artisan anywhere in the world such that he/she could attain them and make/reproduce the cultivar Siokra disclosed in the cited publications.").

Since one skilled in the art could reproduce the plant because it was readily available to the public, then the above referenced publications had an enabling disclosure.

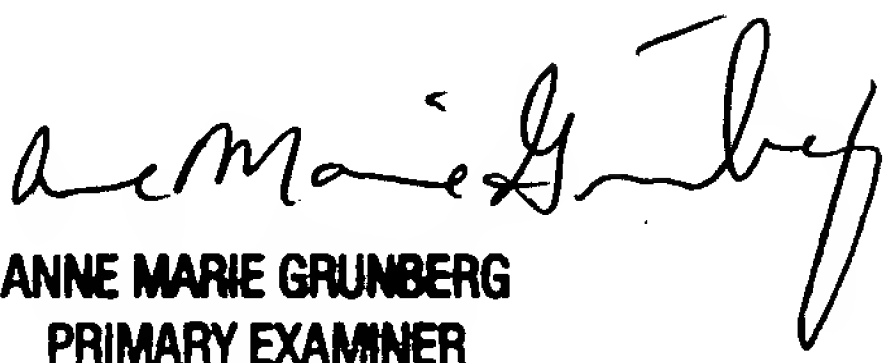
### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H Para whose telephone number is (571) 272-0982. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 4:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax number for the organization where the application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about PAIR system, see <http://pair-direct.uspto.gov> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**ANNE MARIE GRUNBERG**  
**PRIMARY EXAMINER**